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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,898	11/06/2001	David Andrew McMullin	SK-32	5682

7590 11/07/2003

FRIEDRICH KUEFFNER  
317 Madison Avenue  
Suite 910  
NEW YORK, NY 10017

EXAMINER
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ULLAH, AKM E

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,898

Applicant(s)

MCMULLIN ET AL.

Examiner

Akm Enayet Ullah

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 day MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1- 6, drawn to a method for preparing a substrate for supporting at least one optical fiber, classified in class 385, subclass 14.
- II. Claims 7- 21, drawn to a method for preparing an element which supports at least one optical fiber, classified in class 385, subclass 14
- III. Claims 22-23, drawn to a method for the production of a waveguide, classified in class 385, subclass 129.
- IV. Claims 24 – 29, drawn to a substrate for supporting at least one optical fiber, classified in class 385, subclass 141.
- V. Claims 30 – 45, drawn to a precursor sandwich, which supports at least one optical fiber, classified in class 385, subclass 147.
- VI. Claims 46-47, drawn to a waveguide, classified in class 385, subclass 50.

### ***Unrelated Inventions***

Inventions I, II, III, IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I, relates to a method of preparing a substrate and Group II relates to a method for preparing an element, which supports optical fiber. In-group II, such element can be different material besides silica

or polymer or silicon such as metal or rod. Thus, Group I and Group II considered being different invention. Group Group II Group III or I recites a method of preparing a substrate, an element, and production of waveguide which has no relation with Group V where group VI relates to a waveguide structure which has different function and operation to that of an optical waveguide. Thus, Group VI is a different invention.

The differing limitations, which anticipate or makes obvious one of the inventions I-V would not, by itself, make obvious any of the remaining inventions.

Applicant's attention is drawn to the pages 3-13 (summary of the invention) of the specification wherein applicant defines seven different inventions (i.e., line 14 of page 3, line 30 of page 3, line 17 of page 7, line 8 of page 8, line 22 of page 8, line 10 of page 12 and line 29 of page 12).

#### ***Conclusion To All Restriction Requirements***

Because these inventions are distinct for the reasons given above and *have acquired a separate status in the art as shown by their different classification*, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and *have acquired a separate status in the art because of their recognized divergent subject matter*, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and *the search required for invention I is not required for invention II or III or IV or V*, restriction for examination purposes as indicated is proper.

***Requirement, No Election By Telephone***

A telephone call was made to Mr. Friedrich Kueffner on October 21, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

***Requirement, Election, Mailed***

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Joint Inventors, Correction Of Inventorship***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Telephone Inquiry Contacts***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akm Enayet Ullah whose telephone number is 703-308-4885. The examiner can normally be reached on Akm Enayet Ullah from Monday to Wednesday from 5:30 a.m. till 4 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick, can be reached on (703) 308-4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Akm Enayet Ullah  
Primary Examiner  
Art Unit 2874

AUllah